UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,361	07/17/2000	David N. Harris	0013-011	8110

40972	7590	02/28/2005

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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 November 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14-28,30-44 and 46-54* is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-28,30-44 and 46-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All　b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to communication filed on 11/23/04.

2.   Claims 1-12, 14-28, 30-44 and 46-54 are presented for examination.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
       Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 1-12, 14-28, 30-44 and 46-54 are provisionally rejected under the

judicially created doctrine of double patenting over claims 1-36 of copending Application

No. 09/760,271. The instant application further recites a third party for verifying the

approval of the transactions. Official notice is taken that is old and well known for

companies to delegate and appoint /use a third party or an intermediary to conduct

certain functions for the companies. It would have been obvious for a person of

ordinary skill in the art at the time of Applicant's invention to have included a third party

for verifying the approval of the transactions because such a modification would allow

the companies/vendors to concentrate on the other aspects of the transactions. This is

a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: ***

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-4, 14-20, 24-28, 30-36, 40-44, 46-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen 6,422,462 hereinafter Cohen.

With respect to claims 1, 14, Cohen teaches a computer system and corresponding computer method for verifying a commercial transaction comprising. A

processing unit for processing data and code and a memory unit for storing data and

code which includes a merchant communications module to connect with the merchant

for receiving a transaction approval request (col. 5, lines 35-50), data including at

least one pre-verification criteria associated with the account holder (col. 7, lines

20-67)., and code further including an authorization module responsive to the

transaction approval request to compare the request with the pre-verification

criteria and to verify the request if the criteria is satisfied (col. 5, lines 45-50, col.7, line

20 - col. 8, line 67). Cohen also teaches a plurality of verification criteria are satisfied

(col. 7, line 65 - col. 8, line 40), the criteria are determined by the account holder (col. 7,

lines 20-25, col. 9, lines 15-25), receive and establish a connection with the account

holder, authenticate the account holder, present at least one criteria to the account

holder, and receive modification instructions from the account holder (col. 3, lines 40-55,

col. 12, lines 34-60), an authorization module responsive to receipt of said transaction

approval request and operative to transmit an approval to said merchant only if said

transaction approval request is verified by said account-holder (i.e. in accounts where

the transaction is in excess of the predetermined ceiling, an approval or verification of

identity will be required for the account holder)(col. 9, lines 58 to col. 10, lines 1-3), and

wherein said authorization module responsive to instructions from said account-holder

is operative to automatically verify subsequent transaction approval requests without

further input from said account-holder (i.e. on subsequent purchases that are not in

excess of the predetermined ceiling, the transaction will be conducted without

verification of identity from the account holder (col. 9, lines 58 to col. 10, lines 1-3).

Claims 2-4, 15 further recites the authorization interactive module operative to

initiate the connection with said account holder (i.e. Cohen teaches on col. 9, lines 58 to

col. 10, lines 1-12 that in the cases wherein an authorization is required. For example,

for large transactions, authorization will be required from the account holder in order for

the account holder to verify, authorize or provide the identification information, the

account holder replies by supplying the information requested).

With respect to claims 17,30, 33, 46 Cohen teaches receiving a transaction

approval request from said merchant, said approval request including a complete

account number identifying said account-holder's account (col. 5, lines 35-50);

electronically verifying said transaction approval request with said account-holder via a

communication with said account-holder separate from said communication with said

merchant (col. 3, lines 40-55 and col. 12, lines 34-60); receiving instructions from said

account-holder to selectively enable or disable said step of electronically verifying said

transaction approval request (i.e. the account holder enables or disables the transaction .

limits that are subject to verification)(col. 9, lines 58 to col. 10, lines 1-3).

With respect to claims 18-20, 31, 34-36, 47 further recite prompting an account-

holder to verify said transaction request and receiving a reply from the account holder

(i.e. Cohen teaches on col. 9, lines 58 to col. 10, lines 1-12 that in the cases wherein an

authorization is required. For example, for large transactions, the account holder will be

contacted in order for the account holder to verify, authorize or provide the identification

information, the account holder replies by supplying the information requested).

With respect to claims 24-28, 40-44, 49, 51-52 Cohen further teaches the

account holder initiates the verification process (i.e. the user can request authorization

automatically on the actual purchases or upon demand)(col. 12, lines 65).

With respect to claims 16 and 33 Cohen teaches verification by third party

financial institution (i.e. the credit card company is acting as an intermediary or third

party between the account-holder and the vendors for verifying the approval of the

transaction)(col. 12, lines 34 to col. 13, lines 1-6).

With respect to claims 50 and 53-54, Cohen further teaches a processing unit

and memory device with code including a financier communications module operative to

facilitate a connection with a financier for receiving a verification request, an account

holder communications module to facilitate a connection with the account holder; and

an authorization module responsive to the receipt request and transmitting an approval

to the financier (col.12, lines 34 to col. 13, lines 1-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 5-12, 21-23, 37-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cohen in view of Official Notice.

Claims 5-7, 21-23, 37-39 further recite placing an automated telephone call to

said account holder. Cohen teaches communicating and requesting

verification/authorization from the customer on large transactions. Cohen is silent as to

the method used for communicating with the account holder. Official notice is taken that

is old and well known to place an automated call to convey information between

parties. For example, doctor's offices often leave an automated messages to patients

reminding them of their upcoming appointments. It would have been obvious to a

person of ordinary skill in the art at the time of Applicant's invention to have included

placing an automated telephone call to said account holder.

With respect to claims 8-12, Cohen further teaches the account holder initiates

the verification process (i.e. the user can request authorization automatically on the

actual purchases or upon demand)(col. 12, lines 65).

Response to Arguments

7.   Applicant's arguments filed 11/15/2004 have been fully considered but they are

not persuasive.

8.   Applicant argues that Cohen doesn't teach verifying the transaction approval

request with said account-holder if at least one pre-qualification criteria is not satisfied.

As stated above in the rejection, Cohen teaches that if a transaction is in excess of the

predetermined ceiling then the transaction is subject to verification (col. 9, lies 65 to col.

10, lines 1-3). In this case, Cohen does not automatically decline the particular

transaction but verifies the identity of the card-holder for this large transaction that

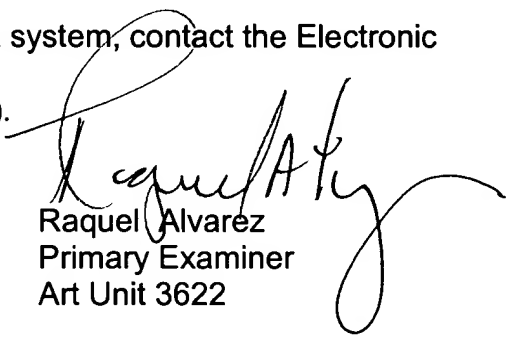doesn't meet the pre-transaction requirements.

Point of contact

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Raquel Alvarez whose telephone number is (703)305-

0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

For the upcoming move to the new Alexandria office, everyone has been

assigned new phone and RightFax numbers. My new phone number will be : 571-272-

6715, my supervisor's phone number will be: 571-272-6724.. This changes will not

happen until April 2005 (or later) and therefore our current numbers are still in service

until the move.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
2/15/05